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Appl. No. : 09/298,763
Applicant : R. Wood et al.
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Group Art Unit : 2622
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ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF

SIR:

This brief is in furtherance of the Notice of Appeal, filed in this case on May 24, 2004.

1. REAL PARTY IN INTEREST

The real party in interest in this matter is The Internet Money Exchange Pty, Ltd.

(Recorded April 23, 1999; Reel/Frame 9915/0308).

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals.

3. STATUS OF THE CLAIMS

Claims 1-39 are pending in this application. Claim 22 was rejected under 35 U.S.C. § 112, first paragraph. Claims 1-39 were rejected under 35 U.S.C. §§ 102(e) and 103(a).

4. STATUS OF AMENDMENTS

Applicants submitted an amendment of several of the pending claims in a Response filed on May 24, 2004. In an Advisory Action dated July 22, 2004, the Examiner indicated that the amendments to the claims would no be entered upon filing a Notice of Appeal. The attached claims reflect their status prior to the May 24, 2004 Response.

5. SUMMARY OF THE INVENTION

The present invention is directed to a system that allows potential consumers to easily collect rewards, that enables the flexible and easy redemption of rewards, and that can direct traffic to promoters' websites.

Referring to Fig. 2, there is illustrated a typical network environment applicable to a representative embodiment of the present invention. As discussed above, the user's computer 2 is coupled to the Internet 20. Also coupled to the Internet is a computer 50 operated by a system administrator of the scheme. The system administrator has a website 52 controlled by the computer 50, typically a webserver computer. The computer 50 also runs an application program 54 and a central database 56. The central database 56 and computer 50 are maintained

by the system administrator. The central database, as discussed in detail below, stores the available offers and rewards.

The central database 56 can be implemented using a database program that can be accessed, directly or indirectly, via the Internet 20. For example, the Microsoft SQL Server or Oracle database program can be used to implement the central database 56.

The application program 54 runs the reward application which applies logic to the parameters in the Offer Table (see Fig. 7) within the central database 56 as well as check for unique values (if applicable). The reward application also validates and, if applicable, expires redeemed rewards.

A user, using the user computer 2, will access content, such as websites, via the Internet 20 (e.g., website 32). This website 32 can be made available to Internet users via a webserver computer 30 as is well known in the art. The website 32 may include an advertisement 34. The advertisement 34 advertises the goods and services of the promoter. According to the representative embodiment, the advertisement 34 can include a rewards indicator 36, such as distinctive rewards logo, border or icon. The rewards indicator 36 signifies that the advertisement 34 is participating in the instant rewards program of the present invention.

In the representative embodiment, the promoter also has a website 42, controlled by a computer 40 that is coupled to the Internet 20. This website 42 also can be made available to Internet users via the webserver computer 40 as is well known in the art.

As stated at page 14-15 of the application, the present invention includes the following benefits and features:

- does not require pre-registration;

- provides easy-to-redeem rewards; and
- will likely attract significant traffic to the promoter's website.

For example, a user simply clicks on an advertisement located on a webpage. The user can be automatically identified. A reward can be automatically allocated to the user. The user's Internet browser (for example) is then automatically redirected to the website of the appropriate promoter. This all can be done without user intervention.

6. ISSUES

- A. Does the specification as filed support claim 22?
- B. Are claims 1, 5-13, 16-22, 24, 25, 32-35 and 38 anticipated by U.S. Patent No. 5,855,007 to Jovicic et al. ("Jovicic")?
- C. Are claims Claims 2-4, 14-15, 23, 26-31, 36, 37 and 39 unpatentable over Jovicic?

7. GROUPING OF CLAIMS

Claims 1-39 may be grouped together for the purpose of this appeal only.

8. ARGUMENT

A. Legal Background

Under 35 U.S.C. § 102(e), a claim is invalid if the invention claimed therein is described in a patent filed prior to the invention of the Applicants and issuing thereafter. Though a patent

reference may have issued early enough, that reference must also enable one skilled in the art to practice the claimed invention. See Akzo N.V. v. U.S. Int'l Trade Comm'n, 1 U.S.P.Q.2d (BNA) 1241, 1245 (Fed. Cir. 1986).

Absent anticipation it may be possible to combine two or more patents together to render a claimed invention obvious, and unpatentable, under 35 U.S.C. § 103(a). In determining whether the claims are unpatentable it is necessary to look to what the references actually teach. “It is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In Re Wesslau, 147 U.S.P.Q. (BNA) 391, 393 (C.C.P.A. 1965). Accordingly, a prior art reference must be considered in its entirety, and portions thereof must be taken in proper context. MPEP § 2141.02; Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 230 U.S.P.Q. (BNA) 416, 419 (Fed. Cir. 1986).

B. Argument

1. §112, First Paragraph Rejection

Claim 22 was rejected under 35 U.S.C. § 112, First Paragraph. Claims 20 and 22 are provided below for convenience:

20. An interactive computer-controlled reward system to allow a user to collect rewards, the system comprising:
a computer network;

a user computer coupled to the computer network, the user computer enabling the user to select advertising images with associated reward indicators;

a central computer coupled to the computer network, the central computer comprising a database, the database storing a list of available offers, said offers identifying promotional incentives and including rewards and conditions associated with the available offers and a promoter and registered users and the rewards allocated to each user; and

a promoter computer coupled to the computer network;

wherein, when the user selects an advertising image with an associated reward indicator, control is passed to the central computer which identifies the user and automatically allocates a reward to the user without pre-registration of the user, wherein said reward is associated with the selected image.

22. The system of claim 20 wherein the computer network is the Internet, and the central computer is a webserver, and the promoter computer is a webserver.

Looking at Fig. 2, the recited components of claim 22 are shown including a computer network as the Internet (element 20), the central computer as a webserver (elements 50-56) and the promoter computer as a webserver (elements 40-42). Description of the drawing is found in the specification as filed at pages 15-16. There does not appear to be any conflict between this claim and independent claim 20. Accordingly, Appellants respectfully request that the Examiner's rejection of claim 22 under 35 U.S.C. § 112, first paragraph be reversed.

2. §§102(e) and 103(a) Rejections

The Jovicic patent was referred to and distinguished in the Background section of the specification of the present invention, as follows, at p. 5:

“Another example is U.S. Patent No. 5,855,007 to Jovicic et. al. This patent describes an electronic coupon communication system for generating and redeeming product discount coupons over the Internet. Again, the coupon must be stored on or printed at the user’s computer.”

There are many fundamental differences between the present invention and the Jovicic patent. These are differences in purpose, architecture and operation.

The problem that the Jovicic patent aims to solve is the management of coupons. Traditionally, a coupon is a paper-based document that entitles the holder to a discount on a product or service. It is time-consuming to manage coupon collection and redemption.

In contrast, the present invention is directed at exciting users to respond to (e.g., click on) electronic advertisements on the Internet. The present invention provides an incentive to drive traffic to a website.

Because of this fundamental difference of purpose, there are many differences between the claims of the present invention and the Jovicic patent, as discussed below. Moreover, for these reasons, the present invention is not obvious in view of the Jovicic patent.

- ***Jovicic’s coupon is collected and stored by user***

In the Jovicic patent, a user selects and obtains coupons. As stated above, a coupon is a bearer-instrument that entitles the holder to a discount on a product or

service. A coupon must be collected (or “clipped” by the customer), and then provided by the customer to the merchant for redemption.

Thus, in the Jovicic patent, the coupon is provided to the customer/user. Either the coupon is printed at the user’s computer or sent electronically to the user and stored on the memory of the user’s computer. The user then redeems the coupon -- that is, the user provides the coupon to the merchant. In summary, in the Jovicic patent, the user selects a coupon from a central location, the coupon is provided to the user, and the user then provides the coupon to the merchant for redemption.

In contrast, according to the present invention, rewards are stored centrally. There is no need for the rewards to be transmitted to or stored by the user. As stated at page 7, lines 17-20, of the Specification of the present invention, this provides a significant advantage:

“... rewards are maintained in a central database. This makes administration and control of the system simpler and more efficient. Additionally, it prevents users from misplacing rewards to which they are entitled.”

As would be appreciated, a user of the coupons in the Jovicic patent could misplace or lose a coupon prior to redemption. This would not occur in relation to the present invention.

Moreover, in the Jovicic patent there is a communication cost in transmitting the coupon to the user. In contrast, according to the present invention:

“There is no need for rewards to be electronically or otherwise transmitted or sent to the user.” (Specification, p. 11, lines 1-2).

- ***Jovicic's coupon is collected from a central location***

In the Jovicic patent, a user obtains a coupon by visiting a central location (called the "Internet coupon server" in the Jovicic patent). That is, the user goes to a central location to view coupons that are available, and then selects coupons of interest.

In sharp contrast, according to the present invention, there is no central location to view and select rewards prior to allocation to the user. According to the present invention, a reward is allocated to the user when the user selects an advertising image. Typically, an advertising image is a banner advertisement on a webpage. The banner advertisements need not be stored on a central "coupon server" for selection, but typically are available for selection at many different websites.

With respect, the Examiner may have confused the "Internet coupon server" of the Jovicic patent (where coupons which have not been allocated to the user are available for selection by a user) with the central database of the present invention (that stores the rewards that the user is entitled to, the user having previously selected an advertising image.)

In short, in Jovicic, the user selects a coupon from many available coupons from a central "Internet coupon server", and the coupon is then transmitted to the user. In the present invention, the user selects an advertising image (not required to be in a central location) and a reward is allocated (but not necessarily transmitted) to the user and this fact is stored at a central database.

- ***Jovicic does not have a central database of rewards that the user is entitled to redeem and that is accessible by the user***

In the Jovicic patent, once a user selects a coupon, it is transmitted to the user. If the user misplaces the coupon, that is the user's loss. The user cannot access any central location to find out which coupons the user had collected. If the user wishes to redeem a coupon, the user must have possession of it. The Jovicic patent has a central coupon database 130 (and see col. 2, lines 49-51), but the purpose of this coupon database is to create customized coupons, and to prevent fraud, not to allow a user to find out what coupons he or she had collected. For fraud prevention purposes, the Jovicic system would not allow the user to directly interact with coupon database 130 of the Jovicic system.

In contrast, in the present invention, rewards that have been allocated to the user are stored centrally. The user can access this central location to see which rewards the user has "collected." To redeem a reward, the user accesses and interacts with the central location.

For example, in relation to claim 32, the Examiner cites col. 3, lines 11-15 of the Jovicic patent as teaching a central computer comprising a central database storing a list of rewards that have been previously collected by the user and that are available for redemption. Col. 3., lines 11-15 of Jovicic clearly states the opposite, that the coupons are stored "in the memory of the user's general computing device". With respect, the Examiner has misunderstood the architecture of the Jovicic patent.

In relation to claim 7, which is directed to these features, the Examiner does not cite any part of the Jovicic patent that teaches the *allowing access* steps of claim 7. There is no need for the user to have such access in the Jovicic patent, because the user has possession the coupon, which is not necessarily the case in relation to the present

invention.

- ***To redeem Jovicic's coupon, the user must provide it to the merchant***

In the Jovicic patent, if a user wishes to redeem a coupon, the user must provide it to the merchant.

In sharp contrast, in the present invention, the user does not need to have the reward (and the rewards that the user has are centrally stored in the central database). Thus, to redeem a reward, the reward is provided from the central database to the merchant. (See Options 1 and 2 on pages 9 and 10 of the Specification.) Unlike Jovicic, the reward does not need to pass through the user's hands.

- ***Jovicic does not have a "reward indicator"***

In the Jovicic, the coupon specifically sets out that it is a discount coupon and directly specifies the discount.

According to the present invention, and unlike a coupon, the advertising image may not specify the nature of the reward (Specification, page 11). Rather, the advertising image includes a "reward indicator" which is, for example, a distinctive logo, border or icon. The "reward indicator" is in addition to and part of the advertising image, and need not specify the reward to which the user will be entitled if the user selects the advertising image.

- ***Jovicic does not teach directing a local computer to a webpage associated with the coupon***

In the Jovicic, the purpose of the system is to enable users to easily collect coupons. It is not a purpose of the Jovicic patent to increase traffic to Internet websites. It is not inherent to do so in the Jovicic patent, and nowhere does Jovicic suggest such a

purpose.

At the priority date of the present invention, it was not obvious to user coupons as a mechanism to drive traffic to websites or to increase click through rates of banner advertisements. The purpose of a coupon was considered to be to encourage a person to purchase the product shown on the coupon, not to drive traffic to a website (that, according to the present invention, need not be related to the reward at all.)

Accordingly, Appellants respectfully submit that the rejection of claims 1-39 under 35 U.S.C. §§ 102(e) and 103(a) should be reversed.

9. **CONCLUSION**

Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's decision rejecting claims 1-39 and direct the Examiner to pass the case to issue.

The Commissioner is hereby authorized to charge the appeal brief fee of \$170.00 and any additional fees which may be necessary for consideration of this paper to Kenyon & Kenyon Deposit Account No. 11-0600. A copy of this sheet is enclosed for that purpose.

Respectfully submitted,



Shawn W. O'Dowd (Reg. # 34,687)

Date: October 25, 2004

KENYON & KENYON
1500 K Street, NW
Suite 700
Washington, DC 20005
(202) 220-4200 telephone
(202) 220-4201 facsimile
DC1-509,044

APPENDIX

(Brief of Appellants R. Wood et al.
U.S. Patent Application Serial No. 09/298,763)

CLAIMS ON APPEAL

The claims in their current form are presented below:

1. A computer-implemented method for interactively and electronically distributing rewards and for increasing the click-through rate for advertisements, comprising the steps of:

displaying an advertising image on a computer screen of a local computer, the image including a reward indicator, wherein the local computer is coupled to a computer network;

enabling a user to select the advertising image;

at a central location coupled to the computer network, seamlessly determining the identity of the user when said advertising image is selected;

at the central location, automatically allocating a reward associated with the advertising image when said advertising image is selected, wherein said allocating step includes

storing a reward identifier with the identity of the user in a database,

said reward indicator identifying a promotional incentive; and

optionally redirecting the local computer to a webpage associated with the image.

2. The method of claim 1 wherein the step of determining the identity of the user further comprises the steps of:

determining if the local computer comprises a cookie storing an ID number indicating the identity of the user; and

providing the ID number to the central location.

3. The method of claim 1 wherein the step of determining the identity of the user further

comprises the steps of:

- determining if the local computer comprises a cookie storing an ID number indicating the identity of the user;

- if there is no cookie storing an ID number at the local computer, asking the user to input an ID number;

- providing the ID number to the central location; and

- checking the validity of the ID number at the central location.

4. The method of claim 1 wherein the step of determining the identity of the user further comprises the steps of:

- determining if the local computer comprises a datafile storing an ID number indicating the identity of the user and providing the ID number to the central location;

- if there is no datafile storing an ID number at the local computer, asking the user to provide a pre-assigned ID number;

- if the user does not have a pre-assigned ID number, collecting information from the user and thereafter allocating an ID number to the user; and

- if an ID number is provided to the central location, checking the validity of the ID number at the central location.

5. The method of claim 1 wherein the computer network is the Internet and the central location is a webserver coupled to a database, the step of redirecting further comprising the steps:

- providing the local computer with an address of a website comprising the content associated with the image;

- causing a browser program at the local computer to navigate to the website.

6. The method of claim 5 wherein the step of allocating to the user a reward associated with the image further comprises the steps of:

- storing a reward identifier in the database associated with the user; and

- optionally causing a message to be displayed to the user at the local computer informing the user of the reward allocated to the user.

7. The method of claim 5 further comprising the steps of:
 - allowing the user to access the database via the Internet; and
 - providing to the user, via the Internet, a list of rewards that have been allocated to the user.
8. The method of claim 7 further comprising the steps of:
 - allowing the user to select a reward from the list of rewards;
 - providing the local computer with an address of a promoter website comprising the content associated with the reward;
 - causing a browser program at the local computer to navigate to the promoter website; and
 - enabling the user to redeem the reward at the promoter website.
9. The method of claim 8 further comprising the step of expiring the redeemed reward.
10. The method of claim 5 further comprising the steps of:
 - allowing the user to visit a promoter website and engage in a transaction;
 - allowing the user to indicate that the user desires to redeem a reward;
 - passing control to the webserver;
 - providing to the user, via the Internet, a list of applicable rewards that have been allocated to the user as stored in the database;
 - allowing the user to select a reward from the list of applicable rewards;
 - causing a browser program at the local computer to navigate to the promoter website; and
 - redeeming the reward at the promoter website.
11. The method of claim 10 further comprising the step of expiring the redeemed reward.
12. The method of claim 1 wherein the image displayed on the computer screen comprises text.

13. The method of claim 1 wherein the step of displaying an image on a computer screen of a local computer comprises displaying an image on a computer screen of a local computer, the image not comprising a reward indicator.

14. The method of claim 3 wherein the step of asking the user to input an ID number comprises the step of obtaining a unique identifier from a physical memory device.

15. The method of claim 14 wherein the physical memory device is one of a magnetic stripe card or smartcard.

16. The method of claim 1 further comprising the steps of
allowing the user to print the reward at the local computer;
enabling the user to redeem the reward at a physical location.

17. A computer-implemented method for interactively and electronically distributing and redeeming rewards via a computer network and to increase click-through rates for advertisements, the computer network coupled to a user computer and a central computer, the central computer coupled to a database, the computer network also coupled to a plurality of promoter computers, the method comprising the steps of:

at the user computer, displaying an advertising image comprising a reward indicator;

enabling a user to select the advertising image;

at a central computer, determining the identity of the user;

at the central computer, automatically allocating to the user a reward associated with the reward indicator by storing a reward identifier in the database associated with an identity of the user said reward identifying a promotional incentive; and

causing the user computer to connect with one of the plurality of promoter computers associated with the selected advertising image;

when the user wishes to redeem a reward, the central computer providing the user computer with a list of rewards associated with the user as stored in the database;

allowing the user to select a reward;

redeeming the reward at the one of the plurality of promoter computers associated with the selected reward.

18. The method of claim 17 further comprising the step of expiring the redeemed reward.

19. An interactive reward allocation and redemption method comprising:

providing a central computer coupled to a central database for storing rewards allocated to users, the central computer coupled to a computer network of user computers and promoter computers, said rewards identifying promotional incentives for purchase transactions;

if a user at a user computer selects an advertisement with a reward indicator:

- (a) obtaining information to identify the user when the advertisement is selected,
- (b) allocating a reward to the user in the central database, the reward associated with the selected advertisement and a promoter, and
- (c) transferring control to a promoter computer associated with the selected advertisement; and

if a user at a user computer indicates that the user desires to redeem a reward allocated to the user:

- (a) obtaining information to identify the user,
- (b) providing to the user a list of rewards previously allocated to the user,
- (c) allowing the user to select one of the rewards in the list of rewards, and
- (d) instructing the promoter to honor the reward.

20. An interactive computer-controlled reward system to allow a user to collect rewards, the system comprising:

a computer network;

a user computer coupled to the computer network, the user computer enabling the user to select advertising images with associated reward indicators;

a central computer coupled to the computer network, the central computer

comprising a database, the database storing a list of available offers, said offers identifying promotional incentives and including rewards and conditions associated with the available offers and a promoter and registered users and the rewards allocated to each user; and
a promoter computer coupled to the computer network;
wherein, when the user selects an advertising image with an associated reward indicator, control is passed to the central computer which identifies the user and automatically allocates a reward to the user without pre-registration of the user, wherein said reward is associated with the selected image.

21. The system of claim 20 wherein the image is an advertisement with a distinctive reward indicator logo.
22. The system of claim 20 wherein the computer network is the Internet, and the central computer is a webserver, and the promoter computer is a webserver.
23. The system of claim 22 wherein the user computer includes a cookie that stores a user ID.
24. The system of claim 22 wherein control is passed to the promoter computer by the central computer after the central computer allocates a reward to the user.
25. The system of claim 20 wherein control is passed to the promoter computer by the central computer after the central computer allocates a reward to the user.
26. The system of claim 20 wherein the user computer is an automatic teller machine.
27. The system of claim 20 wherein the user computer is a personal data assistant.
28. The system of claim 20 wherein the user computer is a point of sale terminal.
29. The system of claim 20 wherein the user computer is an in-seat entertainment unit.

30. The system of claim 20 wherein the user computer is a self-service kiosk.
31. The system of claim 20 wherein the user computer is a telephone with a computer chip and display screen.
32. An interactive computer-controlled reward system to allow a user to redeem rewards previously collected by the user, each reward associated with a promoter and identifying a promotional incentive, the system comprising:
- a computer network;
 - a central computer coupled to the computer network, the central computer comprising a database, the database storing a list of registered users and a list of rewards that have been previously collected by each user and that are available for redemption;
 - a user computer coupled to the computer network, the user computer enabling the user to select a reward for redemption from the list of rewards previously collected by the user and that are available for redemption; and
 - a promoter computer coupled to the computer network, the promoter computer operated by a promoter;
- wherein, when the user wishes to redeem a reward, control is passed to the central computer which identifies the user and allows the user to select a reward from the list of rewards, and thereafter control is passed to the promoter computer for the user to redeem the selected reward.
33. The system of claim 32 wherein the user computer comprises a printing device to allow the user to print a reward for physical redemption.
34. The system of claim 32 wherein the image is an advertisement with a distinctive reward indicator logo.
35. The system of claim 32 wherein the computer network is the Internet, and the central computer is a webserver, and the promoter computer is a webserver.

36. The system of claim 32 wherein the user computer includes a cookie that stores a user ID.

37. The system of claim 32 wherein the user can access the central computer to transfer a reward on the list of rewards to another registered user.

38. An interactive reward allocation and redemption system to attract traffic to a promoter computer, comprising:

- a central database for storing rewards allocated to users;

- a central computer coupled to the central database and to a computer network of user computers and promoter computers;

- means, located at the central computer, for seamlessly obtaining information to identify a user;

- means, located at the central computer, for automatically allocating a reward to the user in the central database if the user at a user computer selects an advertisement with an optional reward indicator, the reward associated with the selected advertisement and a promoter, said reward further identifying a promotional incentive for purchase transaction;

- means, located at the central computer, for transferring control to a promoter computer associated with the selected advertisement; and

- means, located at the central computer, for providing to the user a list of rewards previously allocated to the user;

- means, located at the central computer, for enabling the user to select one of the rewards in the list of rewards; and

- means to instruct the promoter computer of the promoter associated with the selected reward that a valid reward has been selected for redemption by the user.

39. The system of claim 38 further comprising means to allow a user to transfer a reward in the list of rewards to another registered user.